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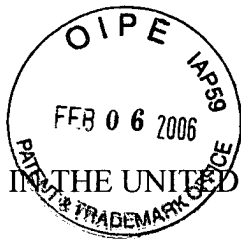
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AUS920010821US1
APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Michael Wayne Brown, *et al.*

Serial No.: 10/015,267

Filed: December 12, 2001

Title: Origin Device Based Callee
Identification

§
§ Group Art Unit: 2645
§
§ Examiner: Elahee, MD S.
§
§ Atty Docket No.: AUS920010821US1
§
§ Customer No. 34533
§

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Catherine Berglund
Catherine Berglund

**REQUEST FOR REINSTATEMENT OF APPEAL AND
APPEAL BRIEF IN SUPPORT OF REINSTATEMENT OF APPEAL**

Honorable Commissioner:

Applicants filed an Appeal Brief in the instant case on April 1, 2005. In response to the Appeal Brief, prosecution was reopened in the non-final Office Action of November 04, 2005. Applicants respectfully request reinstatement of the appeal and submit this supplemental Appeal Brief, filed pursuant to 37 CFR § 41.37, in support of reinstatement of the appeal.

REAL PARTY IN INTEREST

The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-30 and 40-52 are pending in the case. Claim 31-39 were previously withdrawn. All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments have been submitted after receipt of Office Action dated November 3, 2004. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the claimed subject matter according to 37 CFR§ 41.37(c)(1)(v), including references to specification by page and line number and to the drawings if any, by reference characters.

Methods, systems, and products are disclosed for identifying a particular callee, including detecting (S12 at Figure 4), at an origin device (reference 40 at Figure 2), a voice utterance of a callee from a destination device (reference 44 at Figure 2); and identifying (S13, S15, and S23 at Figure 4), at said origin device (reference 40 at Figure 2), a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call described, for example, with reference to Figure 2 at pages 24-28 and Figure 4 at pages 30-35.

Typical embodiments include prompting (S11 at Figure 4) said callee, from said origin device (reference 40 at Figure 2), to provide said voice utterance described, for example, with reference to Figure 2 at pages 24-28 and Figure 4 at pages 30-35.

All such references to the specification identify descriptions and discussions that are part of the detailed descriptions of exemplary embodiments of the present invention in the present application. Such descriptions and discussions are not limitations of the claims in the present application. The only limitations of the claims are set forth in the claims themselves.

GROUND FOR OBJECTIONS

Claims 5-7, 16-18, 27-29, 42 and 47 stand objected to for being dependent upon a rejected base claim.

GROUND OF REJECTION

Claims 1, 4, 11, 12, 15, 22, 23, 26, 50 and 51 stand rejected under 35 U.S.C § 102(e) as being anticipated by Gallick (U.S. Patent No. 6,678,359). Claims 2, 8, 13, 19, 24, and 30 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Bartholomew (U.S. Patent No. 6,167,119). Claims 3, 14 and 25 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of McAllister (U.S. Patent No. 6,101,242). Claims 9 and 20 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Baker (U.S. Patent No. 5,533,109). Claims 10 and 21 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of La Porta (U.S. Patent No. 6,041,103). Claims 40, 41, 43-46, 48, 49 and 52 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Velius (U.S. Patent No. 5,594,784).

ARGUMENT

REJECTION UNDER 35 U.S.C § 102(e) OVER GALLICK

Claims 1, 4, 11, 12, 15, 22, 23, 26, 50 and 51 stand rejected under 35 U.S.C § 102(e) as being anticipated by Gallick (U.S. Patent No. 6,678,359). To anticipate under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Gallick must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Gallick must enable Applicants' claims. Gallick does not meet either requirement and therefore does not anticipate Applicants' claims.

Gallick Does Not Disclose Each and
Every Element of Applicants' Claims

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Independent claim 1 claims:

A method for identifying a particular callee, said method comprising:

detecting, at an origin device, a voice utterance of a callee from a destination device;

identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.

The Office Action states that Gallick discloses detecting, at an origin device, a voice utterance of a callee from a destination device and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1 at Figure 1, Figure 6, column 3, lines 12-53, column 6, lines 3-14, 27-59, and column 7, lines 1-6. These cited portions of Gallick, however, do not teach all the elements for which they are cited and in fact demonstrate that Gallick teaches away from Applicants' claims.

The Office Action argues that the feature server of Gallick is an 'origin device' as claimed in claim 1 in the present application. Specifically, the Office Action states that:

Since feature server is providing the called party's IP address to the calling party (see col. 2, line 61-col. 3, line 2, col. 6, lines 27-29), the feature server is 'origin device' of IP address information. It is noted that applicant didn't claim whether 'origin device' is originating a call or any other signal, it is clear that the feature server is an 'origin device' that generates the admissions Confirm ACF signal and Alerting signal. Office Action Dated November 3, 2005, page 3.

The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention....” *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005). The ordinary and customary meaning of a term may be evidenced by a variety of sources, including: the claims themselves. *Process Control Corp. v HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). It is clear, in the context of claim 1, that the term “origin device” refers to a device originating a call. However, even if it were not clear from the language of claim 1 itself, where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53

USPQ2d 1065, 1069 (Fed. Cir. 1999). The specification of the present application states that:

For purposes of the present invention, telephony devices are termed origin devices when utilized for origination of a call to an intermediary device and are termed destination devices when utilized for receipt of a call from an intermediary device. Specification, page 11, lines 1-15

Thus, it is clear that the term “origin device” in the present application, including the claims, refers to a device utilized for originating a call.

Beginning with Figure 1, Figure 1 of Gallick actually demonstrates that the VoIP Feature server (reference 160 on Figure 1) is not an origin device by showing the VoIP Feature server as distinct from both the VoIP softphones (reference 140 and 141 on Figure 1) and the VoIP telephone (reference 142 on Figure 1). Figure 1 therefore does not disclose a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1 in the present application.

Figure 6 of Gallick shows the Feature server receiving from the calling subscriber a call setup message and sending the called subscriber the call setup message. Figure 6 also demonstrates that the Feature server is not an ‘origin device’ as claimed in claim 1. Figure 6 therefore does not disclose a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1 in the present application.

Column 3, lines 12-53 of Gallick discusses a GUI screen (reference 460 on Figure 4) displayed to a called party making no mention of ‘identifying, at said origin device, a

callee identity' as claimed in claim 1. Column 3, lines 42-53 discusses a capturing and analyzing the first utterances of the called party, but makes no mention whether capturing and analyzing the utterances is carried out by a VoIP softphone, VoIP telephone, or Feature server. Column 3, lines 12-53 of Gallick therefore does not disclose a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1 in the present application.

Column 6, lines 3-14 and lines 27-59 actually teaches away from claim 1 describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Column 6, lines 3-14 and lines 27-59 of Gallick therefore teaches away from a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1.

Column 7, lines 1-6 describes transmitting called ID information to a calling telephone equipped with an Analog Display Services Interface. Column 7, lines 1-6 and lines 27-59 of Gallick does not disclose a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1 in the present application.

Figure 1, Figure 6, column 3, lines 12-53, column 6, lines 3-14, 27-59, and column 7, lines 1-6 of Gallick do not teach the elements of claim 1 as claimed in the present application for which they are cited and in fact demonstrate that Gallick teaches away from claim 1. Gallick does not disclose detecting, at an origin device, a voice utterance

of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call. Independent claim 1 is therefore patentable and should be allowed.

Dependent claims 4 and 11 depend from independent claim 1 and include all of the limitations of claim 1. Because Gallick does not disclose each and every element of claim 1, Gallick does not disclose each and every element of claims 4 and 11.

Independent claim 12 recites a system for identifying a particular callee and stands rejected for the same reasoning as claim 1. Claim 12 claims a system for identifying a particular callee comprising . . . means for detecting, at an origin device, a voice utterance of a callee from a destination device and means for identifying, at said origin device, a callee identity associated with said voice utterance, wherein said callee identity is transmittable as an authenticated identity of said callee for a call. As discussed above with reference to method claim 1, Gallick does not disclose these limitations and therefore cannot anticipate independent claim 12. Claim 12 is patentable and should be allowed.

Dependent claims 15 and 22 depend from independent claim 12 and include all of the limitations of claim 12. Because Gallick does not disclose each and every element of claim 12, Gallick does not disclose each and every element of claims 15 and 22.

Independent claim 23 recites a computer program product for identifying a particular callee and stands rejected for the same reasoning as claim 1. Claim 23 claims a computer program product for identifying a particular callee comprising . . . means, recorded on a recording medium, for detecting a voice utterance of a callee from a destination device at an origin device and means, recorded on a recording medium, for identifying a callee identity associated with said voice utterance, wherein said callee identity is transmittable as an authenticated identity of said callee for a call. As discussed above with reference to

method claim 1, Gallick does not disclose these limitations and therefore cannot anticipate independent claim 23. Claim 23 is patentable and should be allowed.

Dependent claim 26 depends from independent claim 23 and includes all of the limitations of claim 23. Because Gallick does not disclose each and every element of claim 23, Gallick does not disclose each and every element of claim 26.

Independent claim 50 recites a computer program product for identifying a callee and stands rejected for the same reasoning as claim 23 and claim 1. Claim 50 claims a computer program product for identifying a callee comprising . . . means, recorded on a recording medium, for detecting a voice utterance of a callee at an origin device; means, recorded on said recording medium, for authenticating an identity of said callee from said voice utterance at said origin device; and means, recorded on the recording medium, for enabling output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identify of said callee. As discussed above with reference to method claim 1, Gallick does not disclose these limitations and therefore cannot anticipate independent claim 50. Claim 50 is patentable and should be allowed.

Dependent claim 51 depends from independent claim 50 and includes all of the limitations of claim 50. Because Gallick does not disclose each and every element of claim 50, Gallick does not disclose each and every element of claim 51.

Gallick Is Not An Enabling
Disclosure of Applicants' Claims

There are two required aspects of anticipation. Not only must Gallick disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate the claims, but Gallick must also be an enabling disclosure of the claims of the present invention within the meaning of *In re Hoeksema*. The Appellants' claims in *Hoeksema* were rejected because an earlier patent disclosed a close structural

similarity to appellant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." The meaning of *Hoeksema* for the present case is that to anticipate under 35 USC 102(e) Gallick must place one of skill in the art in possession of Applicants' claims.

Independent claim 1 claims:

A method for identifying a particular callee, said method comprising:

detecting, at an origin device, a voice utterance of a callee from a destination device;

identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.

The Office Action states that Gallick discloses detecting, at an origin device, a voice utterance of a callee from a destination device and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1 at Figure 1, Figure 6, column 3, lines 12-53, column 6, lines 3-14, 27-59, and column 7, lines 1-6. These cited portions of Gallick, however, do not enable the elements for which they are cited by placing one of skill in the art in possession with the element for which they are cited.

Beginning with Figure 1, the Office Action argues that the feature server of Gallick as illustrated in Figure 1 is an 'origin device' as claimed in claim 1 in the present application. Office Action Dated November 3, 2005, page 3. Figure 1 of Gallick

actually demonstrates that the VoIP Feature server (reference 160 on Figure 1) is not an origin device by showing the VoIP Feature server as distinct from both the VoIP softphones (reference 140 and 141 on Figure 1) and the VoIP telephone (reference 142 on Figure 1). Figure 1 therefore does not place on of skill in the art in possession of a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1 in the present application. Gallick therefore is not an enabling disclosure.

Figure 6 of Gallick actually shows the feature server receiving from the calling subscriber a call setup message and sending the called subscriber the call setup message. Figure 6 therefore also demonstrates that the feature server is not an 'origin device' as claimed in claim 1. Figure 6 therefore does not place one of skill in the art in possession of a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1. Gallick therefore is not an enabling disclosure.

Column 3, lines 12-53 of Gallick discusses a GUI screen (reference 460 on Figure 4) displayed to a called party making no mention of 'identifying, at said origin device, a callee identity' as claimed in claim 1. Column 3, lines 42-53 discusses a capturing and analyzing the first utterances of the called party, but makes no mention whether capturing and analyzing the utterances is carried out by a VoIP softphone, VoIP telephone, or feature server. Column 3, lines 12-53 of Gallick therefore does not place one of skill in the art in possession of a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for

a call as claimed in claim 1 in the present application. Gallick therefore is not an enabling disclosure.

Column 6, lines 3-14 and lines 27-59 actually teaches away from claim 1 describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Column 6, lines 3-14 and lines 27-59 of Gallick therefore does not place one of skill in the art in possession of a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1 in the present application. Gallick therefore is not an enabling disclosure.

Column 7, lines 1-6 describes transmitting called ID information to a calling telephone equipped with an Analog Display Services Interface. Column 7, lines 1-6 and lines 27-59 of Gallick does not place one of skill in the art in possession of a method for identifying a particular callee that includes detecting, at an origin device, a voice utterance of a callee from a destination device; and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in claim 1. Gallick therefore is not an enabling disclosure.

Figure 1, Figure 6, column 3, lines 12-53, column 6, lines 3-14, 27-59, and column 7, lines 1-6 of Gallick do not place on of skill in the art in possession of the elements of claim 1 for which they are cited and in fact demonstrate that Gallick is not an enabling disclosure of claim 1. Independent claim 1 is therefore patentable and should be allowed.

Independent claims 12, 23, and 50 recite systems and computer program products and stand rejected for the same reasoning as claim 1. As discussed above with reference to method claim 1, Gallick does not place one of skill in the art in possession of the

limitations of claims 12, 23, and 50 and therefore cannot enable or anticipate independent claims 12, 23, and 50. Claims 12, 23, and 50 are patentable and should be allowed.

Dependent claims 4, 11, 15, 22, 26, and 51 depend from independent claims 12, 23, and 50 respectively include all of the limitations of the claims from which they depend.

Because Gallick does not place one of skill in the art in possession of claims 12, 23, and 50, Gallick does not place one of skill in the art in possession of claims 4, 11, 15, 22, 26, and 51. Claims 4, 11, 15, 22, 26, and 51 are patentable and should be allowed.

CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 2, 3, 8, 9, 10, 13, 14, 19, 20, 21, 24, 25, 30, 40, 41, 43-46, 48, 49 and 52 stand rejected under 35 U.S.C § 103(a) as unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Bartholomew (U.S. Patent No. 6,167,119), McAllister (U.S. Patent No. 6,101,242), Baker (U.S. Patent No. 5, 533,109), La Porta (U.S. Patent No. 6,041,103), or Velius (U.S. Patent No. 5,594,784). Applicants respectfully traverse each rejection. Not one of the proposed combinations can establish a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Gallick and Bartholomew, McAllister, Baker, La Porta or Velius. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Gallick and Bartholomew, McAllister, Baker, La Porta or Velius. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Gallick and Bartholomew, McAllister, Baker, La Porta or Velius must teach or suggest all of

Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, the proposed combination of Gallick and Bartholomew, McAllister, Baker, La Porta or Velius cannot establish a prima facie case of obviousness. The rejection of claims should therefore be withdrawn and the case should be allowed.

Gallick and Bartholomew

Claims 2, 8, 13, 19, 24 and 30 stand rejected under 35 U.S.C § 103(a) as unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Bartholomew (U.S. Patent No. 6,167,119). The combination of Gallick and Bartholomew cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of 2, 8, 13, 19, 24 and 30, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination of Gallick and Bartholomew

Do Not Teach All of Applicants' Claim Limitations

The combination of Gallick and Bartholomew does not teach or suggest all of Applicants' claim limitations. Claims 2, 8, 13, 19, 24 and 30 depend from claims 1, 12, and 23 respectively and include all the limitations from which they depend. As discussed above, claim 1 claims identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call. As shown above, Gallick actually teaches away from Applicants' claims at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Bartholomew also teaches away from the claims by teaching an "intelligent peripheral," which is an intermediary network component. The definition of the IP of Bartholomew is incorporated by reference from U.S. Patent No. 5,572,583 and the IP of Bartholomew is defined as "a separate network component that . .

. is distinct from the telephone company switching offices, trunk networks and any associated interoffice signaling network.” U.S. Patent No. 5,572,583, Abstract. Bartholomew teaches that “when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party.” U.S. Patent No. 6,167,119, column 33, lines 40-45. That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. Neither Bartholomew nor Gallick teach or suggest identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call and therefore do not teach or suggest each and every element of the claims of the present application. The combination of Bartholomew and Gallick cannot establish a *prima facie* case of obviousness.

No Suggestion or Motivation to Combine

Gallick and Bartholomew

There is no suggestion or motivation to combine Gallick and Bartholomew, because both Gallick and Bartholomew teach away from the claims. That is, both Gallick and Bartholomew teach away from identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed, for example, in claim 1. Teaching away from the claims is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Gallick teaches away from the claims of the instant application at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Bartholomew also teaches away from the claims by teaching an “intelligent peripheral,” which is an intermediary network component. The IP of Bartholomew is a “a separate network component that . . . is distinct from the telephone company switching offices, trunk networks and any associated interoffice

signaling network.” U.S. Patent No. 5,572,583, abstract. Bartholomew teaches that “when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party.” U.S. Patent No. 6,167,119, column 33, lines 40-45. That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. Because both Gallick and Bartholomew teach away from the claims, there is no suggestion or motivation to combine Bartholomew and Gallick and the proposed combination cannot establish a prima facie case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Gallick and Bartholomew

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and Bartholomew. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As discussed above, Gallick at column 6, lines 3-14 and lines 27-59 describes a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Bartholomew discloses an “intelligent peripheral,” which is an intermediary network component. The IP of Bartholomew is “a separate network component that . . . is distinct from the telephone company switching offices, trunk networks and any associated interoffice signaling network.” U.S. Patent No. 5,572,583, abstract. Bartholomew teaches that “when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party.” U.S. Patent No. 6,167,119, column 33, lines 40-45. Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. Neither the destination softphone processing of Gallick or IP processing of Bartholomew will work to identify a particular callee by detecting, at an origin device, a voice utterance of a callee from a destination device and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for

a call. As such, the combination of Gallick and Bartholomew cannot support a prima facie case of obviousness.

Gallick and McAllister

Claims 3, 14, and 25 stand rejected under 35 U.S.C § 103(a) as unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of McAllister (U.S. Patent No. 6,101,242). The combination of Gallick and McAllister cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of 3, 14, and 25, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination of Gallick and McAllister

Do Not Teach All of Applicants' Claim Limitations

The combination of Gallick and McAllister does not teach or suggest all of Applicants' claim limitations. Claims 3, 14, and 25 depend from claims 1, 12, and 23 respectively and include all the limitations from which they depend. As discussed above, claim 1 claims identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call. As shown above, Gallick actually teaches away from Applicants' claims at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. McAllister also does not teach or suggest the limitations of Applicants' claims. McAllister also teaches away from the claims of the instant application by teaching an "intelligent peripheral," which is an intermediary network component. U.S. Patent No. 6,101,242, column 12, lines 48-57, McAllister teaches the preferred telephone network also includes one or more intelligent peripherals (IPs) to provide enhance announcement and digit collection capabilities and speech recondition. U.S. Patent No. 6,101,242, column 12, lines 48-52. Neither McAllister nor Gallick teach or suggest identifying, at said origin device, a callee identity associated with said voice

utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call and therefore neither McAllister nor Gallick teach or suggest each and every element of the claims of the present application. The combination of McAllister and Gallick cannot establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine
Gallick and McAllister

There is no suggestion or motivation to combine Gallick and McAllister, because both McAllister and Gallick teach away from the claims. That is, both Gallick and McAllister teach away from identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed, for example, in claim 1. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Gallick teaches away from Applicants' claims at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. McAllister teaches away from the claims by teaching an "intelligent peripheral," which is an intermediary network component. McAllister teaches the preferred telephone network also includes one or more intelligent peripherals (IPs) to provide enhance announcement and digit collection capabilities and speech recondition. U.S. Patent No. 6,101,242, column 12, lines 48-52. Because both McAllister and Gallick teach away from the claims, there is no suggestion or motivation to combine McAllister and Gallick and the proposed combination cannot support a prima facie case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Gallick and McAllister

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and McAllister. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As discussed above, Gallick at column 6, lines 3-14 and lines 27-59 describes a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. McAllister teaches the preferred telephone network also includes one or more intelligent peripherals (IPs) to provide enhance announcement and digit collection capabilities and speech recondition. U.S. Patent No. 6,101,242, column 12, lines 48-52. Neither the destination softphone processing of Gallick or IP processing of McAllister will work to identify a particular callee by detecting, at an origin device, a voice utterance of a callee from a destination device and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call. As such, the combination of Gallick and McAllister cannot support a prima facie case of obviousness.

Gallick and Baker

Claims 9 and 20 stand rejected under 35 U.S.C § 103(a) as unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Baker (U.S. Patent No. 5,533,109). The combination of Gallick and Baker cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 9 and 20, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination of Gallick and Baker
Do Not Teach All of Applicants' Claim Limitations

The combination of Gallick and Baker does not teach or suggest all of Applicants' claim limitations. Claims 9 and 20 depend from claims 1 and 12 respectively and include all the limitations from which they depend. As discussed above, claim 1 claims identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call. As shown above, Gallick actually teaches away from Applicants' claims at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Baker also does not teach or suggest these limitations. Baker discloses a "private branch exchange system having various call servicing features for calls terminating at branch exchange telephonic units of the system." Baker, column 1, lines 6-12. Baker does not teach or disclose "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance." Neither Baker nor Gallick teach or suggest each and every element of the claims of the present application. The combination of Gallick and Baker cannot establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine
Gallick and Baker

There is no suggestion or motivation to combine Gallick and Baker, because Gallick teaches away from the claims. That is, Gallick teaches away from identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed, for example, in claim 1. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Gallick teaches away from Applicants' claims at column 6, lines 3-14 and lines 27-59 by describing a local

voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Baker discloses a “private branch exchange system having various call servicing features for calls terminating at branch exchange telephonic units of the system.” Baker, column 1, lines 6-12. Baker does not teach or disclose “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance.” Because Gallick teaches away from the claims, there is no suggestion or motivation to combine Baker and Gallick and the proposed combination cannot support a prima facie case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Gallick and Baker

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and Baker. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As discussed above, Gallick at column 6, lines 3-14 and lines 27-59 describes a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Baker discloses a “private branch exchange system having various call servicing features for calls terminating at branch exchange telephonic units of the system.” Baker, column 1, lines 6-12. Baker does not teach or disclose “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance.” Neither the destination softphone processing of Gallick or the branch exchange of Baker will work to identify a particular callee by detecting, at an origin device, a voice utterance of a callee from a destination device and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call. As such, the combination of Gallick and Baker cannot support a prima facie case of obviousness.

Gallick and La Porta

Claims 10 and 21 stand rejected under 35 U.S.C § 103(a) as unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of La Porta (U.S. Patent No. 6,041,103). The combination of Gallick and La Porta cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 10 and 21, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination of Gallick and La Porta
Do Not Teach All of Applicants' Claim Limitations

The combination of Gallick and La Porta does not teach or suggest all of Applicants' claim limitations. Claims 10 and 21 depend from claims 1 and 12 respectively and include all the limitations from which they depend. As discussed above, claim 1 claims identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call. As shown above, Gallick actually teaches away from Applicants' claims at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. La Porta also does not teach or suggest these limitations. La Porta also teaches away from the Applicants' claims by describing a "method and apparatus for interactive call identification of a call to a called party." La Porta, Abstract, lines 1-2, emphasis added. La Porta does not teach or disclose "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance." Neither La Porta nor Gallick teach or suggest each and every element of the claims of the present application. The combination of Gallick and La Porta cannot establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine
Gallick and La Porta

There is no suggestion or motivation to combine Gallick and La Porta, because both Gallick and La Porta teach away from the claims. That is, Gallick and La Porta teach away from identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed, for example, in claim 1. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Gallick teaches away from Applicants' claims at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. La Porta also teaches away from the Applicants' claims by describing a "method and apparatus for interactive call identification of a call to a called party." La Porta, Abstract, lines 1-2, emphasis added. La Porta does not teach or disclose "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance." Because Gallick and La Porta teach away from the claims, there is no suggestion or motivation to combine La Porta and Gallick and the proposed combination cannot support a prima facie case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Gallick and La Porta

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and La Porta. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As discussed above, Gallick at column 6, lines 3-14 and lines 27-59 describes a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. La Porta also teaches away from the Applicants' claims by describing a "method

and apparatus for interactive call identification of a call to a called party.” La Porta, Abstract, lines 1-2, emphasis added. La Porta does not teach or disclose “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance.” Neither the destination softphone processing of Gallick or the identification of a call to a called party of La Porta will work to identify a particular callee by detecting, at an origin device, a voice utterance of a callee from a destination device and identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call. As such, the combination of Gallick and La Porta cannot support a prima facie case of obviousness.

Gallick and Velius

Claims 40, 41, 43-46, 48, 49 and 52 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Velius (U.S. Patent No. 5,594,784). The combination of Gallick and Velius cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 40, 41, 43-46, 48, 49 and 52, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination of Gallick and Velius

Do Not Teach All of Applicants’ Claim Limitations

The combination of Gallick and Velius does not teach or suggest all of Applicants’ claim limitations. Claims 41, 43, 44, 46, 48, and 49 depend from independent claim 40 and 45 respectively and include all the limitations from which they depend. Claim 52 is an independent claim. Independent claim 40 claims:

A method for identifying a callee, comprising:

detecting a voice utterance of a callee at a origin device originating a call;

authenticating an identity of said callee from said voice utterance at said origin device; and

enabling output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identity of said callee.

Gallick actually teaches away from claim 40 at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Gallick does not teach or disclose “detecting a voice utterance of a callee at a origin device originating a call; authenticating an identity of said callee from said voice utterance at said origin device; and enabling output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identity of said callee.”

Velius also does not teach or suggest the limitations of claim 40. In fact, Velius also teaches away from the Applicants’ claims by disclosing, “The reproduction of the caller’s voice utterance at the call recipient’s location also serves as a form of caller identification, so that the caller may be identified based on his or her unique voice characteristics.” Velius, column 7, lines 29-32, emphasis added. Velius does not teach or disclose “detecting a voice utterance of a callee at a origin device originating a call; authenticating an identity of said callee from said voice utterance at said origin device; and enabling output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identity of said callee.” Neither Velius nor Gallick teach or suggest each and every element of the claims of the present application. The combination of Gallick and Velius cannot establish a prima facie case of obviousness.

Independent claim 45 recites a system for identifying a callee and stands rejected for the same reasoning as claim 40. As discussed above with reference to method claim 40, the

combination of Gallick and Velius does not teach or suggest each and every element of the claims of the present application. Claim 45 is patentable and should be allowed.

Claims 41, 43, 44, 46, 48, and 49 depend from independent claims 40 and 45 respectively and include all of the limitations of the claim from which they depend. Because neither Velius nor Gallick teach or suggest each and every element of claims 40 and 45, the combination of Velius and Gallick cannot teach each and every element of claims 41, 43, 44, 46, 48, and 49. Claims 41, 43, 44, 46, 48, and 49 are patentable and should be allowed.

Turning now to independent claim 52, claim 52 claims:

A method for identifying a particular callee, said method comprising:

detecting, at a call initiating telephony apparatus, a voice utterance of a callee from a destination device; and

identifying, at the call initiating telephony apparatus, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.

Gallick actually teaches away from claim 52 at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Gallick does not teach or suggest “detecting, at a call initiating telephony apparatus, a voice utterance of a callee from a destination device; and identifying, at the call initiating telephony apparatus, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.” Velius also does not teach or suggest the limitations of claim 52. In fact, Velius also teaches away from the Applicants’ claims by disclosing, “The reproduction of the caller’s voice utterance at the call recipient’s location also serves as a form of caller identification, so that the caller may be identified based on his or her unique voice characteristics.” Velius, column 7,

lines 29-32, emphasis added. Velius does not teach or suggest “detecting, at a call initiating telephony apparatus, a voice utterance of a callee from a destination device; and identifying, at the call initiating telephony apparatus, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.” Neither Velius nor Gallick teach or suggest each and every element of the claims of the present application. The combination of Gallick and Velius cannot establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine

Gallick and Velius

There is no suggestion or motivation to combine Gallick and Velius, because both Gallick and Velius teach away from the claims. That is, Gallick and Velius teach away from detecting, at a call initiating telephony apparatus, a voice utterance of a callee from a destination device; and identifying, at the call initiating telephony apparatus, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed, for example, in claim 52. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Gallick teaches away from Applicants’ claims at column 6, lines 3-14 and lines 27-59 by describing a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Velius also teaches away from the Applicants’ claims by disclosing, “The reproduction of the caller’s voice utterance at the call recipient’s location also serves as a form of caller identification, so that the caller may be identified based on his or her unique voice characteristics.” Velius, column 7, lines 29-32, emphasis added. Because Gallick and Velius teach away from the claims, there is no suggestion or motivation to combine Velius and Gallick and the proposed combination cannot support a prima facie case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Gallick and Velius

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and Velius. I., 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As discussed above, Gallick at column 6, lines 3-14 and lines 27-59 describes a local voice identification recognizer located on a personal computer or server on the network where the destination softphone resides. Velius discloses, “The reproduction of the caller’s voice utterance at the call recipient’s location also serves as a form of caller identification, so that the caller may be identified based on his or her unique voice characteristics.” Velius, column 7, lines 29-32, emphasis added. Neither the destination softphone processing of Gallick or the identification of a caller at the callee’s location of Velius will work to detect a voice utterance of a callee at a origin device originating a call, authenticate an identity of said callee from said voice utterance at said origin device, and enable output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identity of said callee as claimed in independent claims 40 and 45. Likewise, neither the destination softphone processing of Gallick or the identification of a caller at the callee’s location of Velius will work to detect, at a call initiating telephony apparatus, a voice utterance of a callee from a destination device, and identify, at the call initiating telephony apparatus, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call as claimed in independent claim 52. As such, the combination of Gallick and Velius cannot support a prima facie case of obviousness.

The Four Factual Inquires Required For An Obviousness Rejection Have Not Been
Properly Considered, Determined, And Applied

Establishing a prima facie case of obviousness for claims 2, 3, 8, 9, 10, 13, 14, 19, 20, 21, 24, 25, 30, 40, 41, 43-46, 48, 49 and 52, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of claims 2, 3, 8, 9, 10, 13, 14,

19, 20, 21, 24, 25, 30, 40, 41, 43-46, 48, 49 and 52 under 35 U.S.C. § 103 is deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*. The rejection should therefore be withdrawn and the case allowed.

The *Manual of Patent Examining Procedure* §2141 explicitly states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . .

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as

negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

In over four years of prosecution, the only mention the Examiner has made of the four factual inquiries required by the Supreme Court in *Graham v. John Deere*, is a statement in the most recent Office Action, dated November 4, 2005, indicating that the four factual inquiries exist and are required. However, even that Office Action provided no analysis whatsoever of the four factual inquiries with regard to the present application. The four factual inquiries have not been properly considered, determined, and applied in any of the Office Actions in this case.

The first factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in each Office Action, the Examiner has only identified elements in

Applicants' claims not found in one of the primary references, Gallick or Bartholomew, and then attempted to find a similar element in a secondary reference, i.e., Bartholomew, McAllister, Baker, Gallick, Silverman, Timonen, Kobayashi, La Porta or Velius, to support an obviousness rejection. Such analysis is improper and incomplete.

"Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The Office Actions of November 4, 2005, November 2, 2004, May 7, 2004, October 22, 2003, and April 8, 2003, are deficient because the Examiner has only identified differences between certain elements of Applicants' claims and combinations of references. This analysis is improper and incomplete because Examiner has not determined whether Applicants' claims as a whole would have been obvious in view of the modification of Gallick or Bartholomew according to Bartholomew, McAllister, Baker, Gallick, Silverman, Timonen, Kobayashi, La Porta or Velius and why the claims as a whole would have been obvious. As such, the obviousness rejections should be withdrawn and the case should be allowed.

The second factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include

(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The Office Actions of November 4, 2005, November 2, 2004, May 7, 2004, October 22, 2003, and April 8, 2003, fail to apply a single factor used to determine the level of ordinary skill in the art. In fact, in over four years of prosecution and in five office actions, no analysis at all considering the level of one of ordinary skill in the art for the instant case has been performed. The rejection of claims 2, 3, 8, 9, 10, 13, 14, 19, 20, 21, 24, 25, 30, 40, 41, 43-46, 48, 49 and 52 is therefore deficient and the case should be allowed.

Conclusion

Gallick does not anticipate claims 1, 4, 11, 12, 15, 22, 23, 26, 50 and 51 within the meaning of 35 USC 102. Gallick alone or in combination with Bartholomew, McAllister, Baker, La Porta or Velius does not establish a prima facie case of obviousness according to 35 USC 103. Gallick alone or in combination with Bartholomew, McAllister, Baker, La Porta or Velius does not teach each and every element of claims 2, 3, 8, 9, 10, 13, 14, 19, 20, 21, 24, 25, 30, 40, 41, 43-46, 48, 49 and 52. The proposed combinations of Gallick, Bartholomew, McAllister, Baker, La Porta or Velius also fail to establish a prima facie case of obviousness because the proposed combinations present no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combinations. Applicants therefore respectfully request the allowance of claims 1-30 and 40-52.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

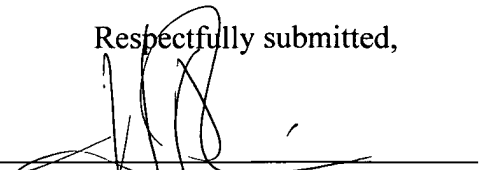
APPEAL BRIEF

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447
for any fees required or overpaid.

Respectfully submitted,

Date: February 3, 2006

By:


H. Artoush Ohanian

Reg. No. 46,022

Biggers & Ohanian, LLP

P.O. Box 1469

Austin, Texas 78767-1469

Tel. (512) 472-9881

Fax (512) 472-9887

ATTORNEY FOR APPELLANTS

APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, *ET AL.*, SERIAL NO. 10/015,267

CLAIMS

What is claimed is:

1. A method for identifying a particular callee, said method comprising:

detecting, at an origin device, a voice utterance of a callee from a destination device;

identifying, at said origin device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.

2. The method for identifying a particular callee according to claim 1, further comprising:

prompting said callee, from said origin device, to provide said voice utterance.

3. The method for identifying a particular callee according to claim 1, further comprising:

prompting said callee to enter an additional input to verify said callee identity.

4. The method for identifying a particular callee according to claim 1, wherein identifying a callee identity further comprises:

extracting speech characteristics from said voice utterance; and

comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callees.

5. The method for identifying a particular callee according to claim 1, further comprising:

transmitting said voice utterance to a third party device via a network; and

receiving said callee identity from said third party device.

6. The method for identifying a particular callee according to claim 1, further comprising:

requesting a voice sample for said particular callee from a third party device accessible via a network; and

receiving said voice sample for said particular callee for enabling authenticating of said callee identity.

7. The method for identifying a particular callee according to claim 1, further comprising:

displaying said callee identity to said caller at said origin device, wherein said caller is enabled to select whether to continue said call according to said callee identity.

8. The method for identifying a particular callee according to claim 1, further comprising:

enabling said caller to identify a preferred callee at said origin device; and

transferring an identifier for said preferred callee to said destination device, wherein said destination device is enabled to adjust output according to said identifier for said preferred callee.

9. The method for identifying a particular callee according to claim 1, wherein said origin device is a private exchange network.

10. The method for identifying a particular callee according to claim 1, wherein said origin device is a telephony device.

11. The method for identifying a particular callee according to claim 1, wherein said callee identity comprises at least one from among a callee name, a callee location, a subject of said call, and a device identification.

12. A system for identifying a particular callee, said system comprising:

an origin device connected to a telephone network;

means for detecting, at said origin device, a voice utterance of a callee from a destination device;

means for identifying, at said origin device, a callee identity associated with said voice utterance, wherein said callee identity is transmittable as an authenticated identity of said callee for a call.

13. The system for identifying a particular callee according to claim 12, further comprising:

means for prompting said callee, from said origin device, to provide said voice utterance.

14. The system for identifying a particular callee according to claim 12, further comprising:

means for prompting said callee to enter an additional input to verify said callee identity.

15. The system for identifying a particular callee according to claim 12, wherein said means for identifying a callee identity further comprises:

means for extracting speech characteristics from said voice utterance; and

means for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callees.

16. The system for identifying a particular callee according to claim 12, further comprising:

means for transmitting said voice utterance to a third party device via a network;
and

means for receiving said callee identity from said third party device.

17. The system for identifying a particular callee according to claim 12, further comprising:

means for requesting a voice sample for said particular callee from a third party device accessible via a network; and

means for receiving said voice sample for said particular callee for enabling authenticating of said callee identity.

18. The system for identifying a particular callee according to claim 12, further comprising:

means for displaying said callee identity to said caller at said origin device, wherein said caller is enabled to select whether to continue said call according to said callee identity.

19. The system for identifying a particular callee according to claim 12, further comprising:

means for enabling said caller to identify a preferred callee at said origin device; and

means for transferring an identifier for said preferred callee to said destination device, wherein said destination device is enabled to adjust output according to said identifier for said preferred callee.

20. The system for identifying a particular callee according to claim 12, wherein said origin device is a private exchange network.

21. The system for identifying a particular callee according to claim 12, wherein said origin device is a telephony device.

22. The system for identifying a particular callee according to claim 12, wherein said callee identity comprises at least one from among a callee name, a callee location, a subject of said call, and a device identification.

23. A computer program product for identifying a particular callee, said computer program product comprising:

a recording medium;

means, recorded on said recording medium, for detecting a voice utterance of a callee from a destination device at an origin device;

means, recorded on said recording medium, for identifying a callee identity associated with said voice utterance, wherein said callee identity is transmittable as an authenticated identity of said callee for a call.

24. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for prompting said callee, from said origin device, to provide said voice utterance.

25. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for prompting said callee to enter an additional input to verify said callee identity.

26. The computer program product for identifying a particular callee according to claim 23, wherein said means for identifying a callee identity further comprises:

means, recorded on said recording medium, for extracting speech characteristics from said voice utterance; and

means, recorded on said recording medium, for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callees.

27. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for controlling transmission of said voice utterance to a third party device via a network; and

means, recorded on said recording medium, for enabling receipt of said callee identity from said third party device.

28. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for requesting a voice sample for said particular callee from a third party device accessible via a network; and

means, recorded on said recording medium, for enabling receipt of said voice sample for said particular callee for enabling authenticating of said callee identity.

29. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for controlling output of said callee identity to said caller at said origin device, wherein said caller is enabled to select whether to continue said call according to said callee identity.

30. The computer program product for identifying a particular callee according to claim 23, further comprising:

means, recorded on said recording medium, for enabling said caller to identify a preferred callee at said origin device; and

means, recorded on said recording medium, for transferring an identifier for said preferred callee to said destination device, wherein said destination device is enabled to adjust output according to said identifier for said preferred callee.

40. A method for identifying a callee, comprising:

detecting a voice utterance of a callee at a origin device originating a call;

authenticating an identity of said callee from said voice utterance at said origin device; and

enabling output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identity of said callee.

41. The method for identifying a callee according to claim 40, further comprising:

comparing said voice utterance with at least one voice imprint stored at said origin device; and

responsive to matching said voice utterance with said at least one voice imprint, authenticating said identity of said callee according to a callee identification stored in association with said voice imprint.

42. The method for identifying a callee according to claim 40, further comprising:

accessing at least one voice imprint from a third party server; and

responsive to matching said voice utterance with said at least one voice imprint, authenticating said identity of said callee according to a callee identification stored in association with said voice imprint.

43. The method for identifying a callee according to claim 40, wherein said output comprises displayable output to a graphical user interface.

44. The method for identifying a caller according to claim 40, wherein said output comprises audio output via a speaker.

45. A system for identifying a callee, comprising:

an origin device for originating a call;

means for detecting a voice utterance of a callee at said origin device;

means for authenticating an identity of said callee from said voice utterance at said origin device; and

means for enabling output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identity of said callee.

46. The system for identifying a callee according to claim 45, further comprising:

means for comparing said voice utterance with at least one voice imprint stored at said origin device; and

means responsive to matching said voice utterance with said at least one voice imprint, for authenticating said identity of said callee according to a callee identification stored in association with said voice imprint.

47. The system for identifying a callee according to claim 45, further comprising:

means for accessing at least one voice imprint from a third party server; and

means responsive to matching said voice utterance with said at least one voice imprint, for authenticating said identity of said callee according to a callee identification stored in association with said voice imprint.

48. The system for identifying a callee according to claim 45, wherein said output comprises displayable output to a graphical user interface.

49. The system for identifying a caller according to claim 45, wherein said output comprises audio output via a speaker.

50. A computer program product for identifying a callee, comprising:

a recording medium;

means, recorded on said recording medium, for detecting a voice utterance of a callee at an origin device;

means, recorded on said recording medium, for authenticating an identity of said callee from said voice utterance at said origin device; and

means, recorded on said recording medium, for enabling output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identity of said callee.

51. The computer program product for identifying a callee according to claim 50, further comprising:

means, recorded on said recording medium, for comparing said voice utterance with at least one voice imprint stored at said origin device; and

means, recorded on said recording medium, for authenticating said identity of said callee according to a callee identification stored in association with a voice imprint responsive to matching said voice utterance with said voice imprint.

52. A method for identifying a particular callee, said method comprising:

detecting, at a call initiating telephony apparatus, a voice utterance of a callee from a destination device; and

identifying, at the call initiating telephony apparatus, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.